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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,384	12/06/2001	Atsushi Fukuzato	05030020AA	5355

7590 10/07/2004

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EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,384

Applicant(s)

FUKUZATO, ATSUSHI

Examiner

Joy K Contee

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date September 24, 2003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (Johansson), U.S. Patent No. 5,418,837, in view of Hofmann, U.S. Patent No. 6,311,241.

Regarding claim 1, Johansson discloses a method for backing up applications of a portable cellular phone comprising:

a step of storing application information (i.e., reads on upgrading software) to be used in said portable cellular phone and identification information used to identify said portable cellular phone in a backup memory (i.e., reads on "handshaking" with or without encryption) (col. 4, lines 39-46 and line 51- to col. 5, line 30);

a step of transferring, when said application information is backed up, said application information with said identification information being added from said backup device to said portable cellular phone (col. 5, lines 4-30);

a step of said portable cellular phone comparing the transferred identification information with identification information of said portable cellular phone (col. 5, lines 22-27); and

a step of copying said application information only when both of said identification information match each other (col. 5, lines 15-30).

Johansson fails to explicitly disclose a backup memory "device".

In a similar field of endeavor, Hofmann provides evidence of a plug-in device EV which has program data (i.e., reads on application information) stored therein (in PS Program memory). Program data is to be transferred to the electronic unit via an existing input/output interface EAS, e.g., a SIM input/output interface of a mobile radio terminal (see Fig. 2, col. 3, lines 38-50).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the backup memory in Johansson such that it is separate from the mobile unit, a "device", for the purpose of implementing the backup memory in a plug-in device, which existing access is present for a SIM card.

Regarding claim 2, Johansson as modified by Hofmann discloses the method for backing up the applications of the portable cellular phone according to claim 1, wherein said identification information is a manufacture serial number and/or a telephone number (both read on "telephone identification stored in SIM card memory) of said portable cellular phone (see Johansson, col. 5, lines 22-30).

Regarding claim 3, Johansson as modified by Hofmann discloses the method for backing up the applications of the portable cellular phone according to claim 1, wherein said portable cellular phone performs processing of verifying whether or not said applications transferred from said backup device run normally and does not copy said

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transferred application if said application does not run properly (see Johansson, col. 4, lines 51-66).

Regarding claim 4, Johansson as modified by Hofmann discloses the method for backing up the applications of the portable cellular phone according to claim 1, wherein said portable cellular phone stores said application information having undergone the verification processing in said portable cellular phone in an executable format (see Johansson, col. 4, lines 51-66).

Regarding claim 5, Johansson as modified by Hofmann discloses the method for backing up the applications of the portable cellular phone according to claim 3, wherein said portable cellular phone stores said application information having undergone the verification processing in said portable cellular phone in an executable format (see Johansson, col. 4, lines 51-66).

Regarding claim 6, Johansson as modified by Hofmann discloses the method for backing up the applications of the portable cellular phone according to claim 1, wherein said portable cellular phone terminates processing (i.e., reads on "only after handshaking procedure is completed.....upgrading...begin") when said identification information transferred from said backup device does not match the identification information of said portable cellular phone (see Johansson, col. 5, lines 19-22).

3. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson as modified by Hofmann, in further view of Hagebarth, U.S. Patent No. 6,48,026.

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Regarding claim 7, Johansson as modified by Hofmann discloses the method for backing up the applications of the portable cellular phone according to claim 1, but fails to explicitly disclose, wherein said portable cellular phone, when said portable cellular phone uses said application information being stored in said backup device at a time of changing a type of said portable cellular phone, compares said identification information transferred from said backup device with said identification information of said portable cellular phone and copies said transferred application information only when both of said identification information match each other.

In a similar field of endeavor, Hagebarth discloses that a potential customer can use a mobile telephone with an uncleared (i.e., subscriber not cleared for service) SIM card to set up connection to the communications network by making a call within the mobile telephone network with a non-cleared SIM card, the mobile network can cause the calling mobile telephone to transmit the SIM card number stored therein such that SIM can be cleared for use within a mobile telephone (i.e., reads on subscriber getting new phone)(col. 3,lines 48-52 and col. 4,lines 33-52).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination of Johansson and Hofmann to include automatic SIM activation for initialization of a new mobile phone for the purpose of allowing "clearing" or authentication of subscriber to receive services.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson as modified by Hofmann, in further view of Genell, U.S. Patent No. 6,324,411.

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Regarding claim 8, Johansson as modified by Hofmann discloses the method for backing up the applications of the portable cellular phone according to claim 1, but fails to explicitly disclose, wherein, when data is transmitted and/or received between said portable cellular phone and said backup device, information indicating a mode is added to said data.

In a similar field of endeavor, Genell discloses monitoring for the "idle mode" of operation so that software can be loaded to the mobile unit. Hence, it is inherent for information indicating an idle mode to be added to software data (col. 3, line 54 to col. 4, line 2).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination of Johansson and Hofmann to include mode information such that loading or downloading of software/applications/programs is done at a convenient time or mode.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson as modified by Hofmann, in further view of Frank et al. (Frank), U.S. Patent No. 6,728,547.

Regarding claim 9, Johansson as modified by Hofmann discloses the method for backing up applications of the portable cellular phone according to claim 1, but fails to explicitly disclose wherein said application is a Java application.

In a similar field of endeavor, Frank discloses downloading a Java application on a SIM card (col. 2, lines 3-12).

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At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the combination of Johansson and Hofmann to include a Java application to be transferred from SIM to mobile unit since it is well known for the SIM card to have an Java application therein.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hutchison IV et al., U.S. Patent No. 6,449,476, discloses a system and method for independently downloading features.

Darnault et al., U.S. Patent No. 6,484,024, discloses a method for the programming of an instrument.

Floman et al., U. S. Patent No. 6,684,324, discloses a method for installing two or more operating systems/user interfaces into an electronic device.

Touti et al, U.S. Patent No. 6,453,161, discloses an agile service interaction manager for intelligent network services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-0149. The examiner can normally be reached on M (alternating), T & Th, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone

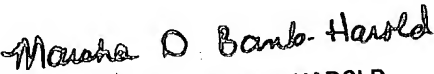
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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joy Contee

September 30, 2004


MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
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